



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
---------------	-------------	----------------------	---------------------

08/464,034 06/05/95 HYATT

E6M1/0627

GILBERT P. HYATT
PO BOX 81230
LAS VEGAS NV 89180

G	751
EXAMINER	
PRIROCKIS, L	
ART UNIT	PAPER NUMBER

2616

DATE MAILED:

06/27/96

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 4/25/96 ☒ This action is made final.
A shortened statutory period for response to this action is set to expire 3 month(s), — days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 21-97 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 21-97 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

Serial Number: 08/464034
Art Unit: 2616

-2-

Part III DETAILED ACTION

Applicant's arguments filed April 22, 1996, have been fully considered but they are not deemed to be persuasive.

1. It is hereby noted that applicant has not notified the Office of the filing of any supplemental amendments, as he has previously in numerous other cases (such as in SN's 08/458,143, 08/456,901, 08/460,422, 08/464,007, and other applications). Therefore, this Action is based on the belief that the response filed in April is the complete response to the previous Office Action and that no supplemental amendment has been filed.

2. Claims 26-97 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The statements of the reasons for this rejection, made in the previous Office Action, are incorporated herein by reference, with the following exceptions.

The rejections of claims 21, 31, 36, 65 and 80 as "incomplete" are withdrawn. Claims 31, 36, 65 and 80 remain rejected under 35 U.S.C. § 112, second paragraph, for other reasons, detailed below and in the previous Office Action.

While applicant is not prohibited from merely claiming elements of an apparatus without specifying how they are intended to work in concert as a complete system, a claim of this type is necessarily far broader as read on the prior art than a claim which, in addition to reciting the elements of an apparatus, distinctly delineates the manner in which

Serial Number: 08/464034
Art Unit: 2616

-3-

claimed elements are to be connected to form the apparatus for achieving the desired functionality. Claims 21, 31, 36, 65 and 80 each recite elements of an apparatus but omit to recite how or even if various elements are connected.

3. Applicant's arguments filed in response to the rejection of the claims under 35 USC §112, second paragraph, have been fully considered but they are not deemed to be persuasive.

Applicant characterizes the rejections of claims 21, 31, 36, 65 and 80 as based on "allege[d] lack of connections." Applicant avers that the claims in question "recite proper coupling and responsiveness."

It is unclear what applicant means by "coupling and responsiveness." The second paragraph of 35 USC § 112 is silent as to a requirement for "coupling and responsiveness." Thus absent a definition of or requirement for "coupling and responsiveness," the matter of what degree of "coupling and responsiveness" the claims exhibit is moot and will not be considered further.

As to claims 31, 36 and 65, although the rejection as "incomplete" is withdrawn, these claims remain rejected under 35 U.S.C. § 112, second paragraph as vague and indefinite, as detailed in the previous Office Action.

As to claim 80, this claim is also rejected as failing to recite a clear antecedent for "the output circuit" to be coupled to the second clock circuit. Prior to this recitation of "the output circuit" the claim recites a "first output circuit," "second output circuit" and "third output circuit." As recited there is no way for one skilled in the art to determine

Serial Number: 08/464034
Art Unit: 2616

-4-

which of the three previously recited "output circuits" the second clock circuit is to be coupled to.

Applicant characterizes the rejections of claims 26, 31, 37, 46, 51, 52, 58, 60, 65, 70, 75, 81-84, 86-93, 96 and 97 as being "based upon insufficient details being recited in the claims" and avers that it is "the purpose of the disclosure (not the claims) to provide the details." This statement incorrectly characterizes the nature of the rejections in most of the claims indicated, since in most of these cases the language objected to is not clearly defined elsewhere in the disclosure, with the result that its use renders the claims vague and indefinite. Three examples of how this statement mischaracterizes the rejections follow.

Example 1: As to claims 26, 37, 65, 70 and 75, the meaning of "input word" cannot be ascertained. The qualifier "input" typically denotes data which is making a first entry into a system. Applicant's recitation of "generating a sequence of input words in response to the image information" is vague and indefinite for several reasons: (I) it is a contradiction in terms, impermissible per MPEP § 608.01(o), to name data "input" when it is in fact extracted from data already stored in the system, (II) no indication whatsoever is made as to what part of the system "input words" are input to, (III) no indication whatsoever is made as to the content of "input words." Applicant has made no attempt to address this specific rejection.

Example 2: As to claims 31, 83 and 84, the meaning of "forth memory" cannot be ascertained. The examiner's dictionary defines "forth" as: "Forward in time, place, or order"; "Into view"; or "Away from a given place." None of these definitions appear to have any relationship to memory, thus the term is vague and indefinite; further applicant

Serial Number: 08/464034
Art Unit: 2616

-5-

has omitted to address this very specific rejection.

Example 3: As to claim 46, "triple line buffer...storing three lines of display information in response to the input line of display information" has been objected to as vague and indefinite, because it is not possible to store three lines of information in response to one line of input information, unless the one input line is replicated three times, which operation would require more than a "buffer" to accomplish; whereas if in fact the device stores three successive lines of information, it is incorrect to recite that the storage is "in response to the [single] input line of display information." In addition, a later recitation of "the double buffered triple line buffer" is made without antecedent in the claim. Applicant has made no effort to clarify or rectify either of these specific inconsistencies.

Applicant characterizes the rejections of claims 33, 85, 92 and 94 as "based upon a lack of antecedent basis." This is incorrect. Claims 85 and 92 are rejected as failing to provide **antecedent or definition** for terms recited therein. Applicant is correct to state that a first recitation cannot have an antecedent, however, absent antecedent, ie, upon first recitation of an element in a claim, one skilled in the art must be able to understand what the recited element is by either dint of its known definition in the art (eg, a "processor" would not be confused with a "display terminal") or by reference to explicit definition in the specification.

Claims 85 and 92 recite generating "input words" and "output words." Not only are these are not standard terms of art; these terms may in fact describe two different things or the same thing, further they may inhabit these contradictory roles at the same time. To

Serial Number: 08/464034
Art Unit: 2616

-6-

wit: A data word transferred from element A to element B is an "output word" as viewed from element A and at the same time an "input word" as viewed from element B. The same data word transferred from element B to element C is an "output word" as viewed from element B and at the same time an "input word" as viewed from element C. Thus the same item may be described by two different terms at the same time, and the same term may be used to describe two different items.

There is no indication in the claim as to where in the image processing system the words are generated. Since "input" and "output" are relative terms in a multi-element system, and since applicant omits to recite what "input" and "output" are relative to, on first presentation, the terms lack definition.

Neither of claims 33 and 94 are rejected for "lack of antecedent basis." Accordingly applicant's traversal of these rejections based on "first presentation" is moot.

The indicated portions of the disclosure have been considered but have not been found to provide sufficient clarification to obviate the rejections of the claims 35 U.S.C. § 112, second paragraph.

4. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 21-24, 26-29, 31-34, 36-41, 43-49, 51-56, 58-63, 65-68, 70-73, 75-78, 80-97, as best that they are understood, are rejected under 35 U.S.C. § 103 as being unpatentable over Marsh (4,179,824).

Rather than repeating the extensive discussion of the applied reference, the statements advanced in the previous (ie., last) Office Action as to the applicability and disclosure of Marsh are incorporated herein, as are the statements of rejection for these claims over Marsh.

5. Claims 25, 30, 35, 42, 50, 57, 64, 69, 74, and 79, as best that they are understood, are rejected under 35 U.S.C. § 103 as being unpatentable over Marsh as applied to claims 21-24, 26-29, 31-34, 36-41, 43-49, 51-56, 58-63, 65-68, 70-73, 75-78, 80-97 above, and further in view of any of Widergren et al. (4,394,774) or Cease et al. (4,596,026) or Forquer et al. (4,491,915).

Rather than repeating the extensive discussion of the applied references, the statements advanced in the previous Office Action as to the applicability and disclosure of Marsh, Widergren et al., Cease et al. and Forquer et al. are incorporated herein, as are the statements of rejection for these claims over Marsh, Widergren et al., Cease et al. and Forquer et al.

Double Patenting - 35 USC §101

6. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process . . . may obtain a patent therefor . . . " (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ

Serial Number: 08/464034
Art Unit: 2616

-8-

330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

7. A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

8. Claims 95-97 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 21, 31 and 39 of each of copending application Serial Nos. included in the following list:

08/458141, 08/456333, 08/458143, 08/458142, 08/456339, 08/457360, 08/457715, 08/457726, 08/457211, 08/457728, 08/457448, 08/457208, 08/458005, 08/458004, 08/458104, 08/456901, 08/457362, 08/456398, 08/457194, 08/457197, 08/456296, 08/456592, 08/458006, 08/457196, 08/459158, 08/460607, 08/458791, 08/459152, 08/459848, 08/460737, 08/460422, 08/460705, 08/458608, 08/460433, 08/461567, 08/459221, 08/458206, 08/460612, 08/460172, 08/458549, 08/464512, 08/464999, 08/465083, 08/461288, 08/460718, 08/460753, 08/459648, 08/464007, 08/464998, 08/469018, 08/463824.

9. Each of these applications contain identical claims 95-97.

10. These are provisional double patenting rejections since the claims have not in fact been patented.

Double Patenting - Non-statutory/Obvious-type

11. The non-statutory double patenting rejection, whether of the obvious-type or non-obvious-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

12. A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double

Serial Number: 08/464034
Art Unit: 2616

-9-

patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78 (d).

13. Effective January 1, 1994, a registered attorney or agent of record may sign a Terminal Disclaimer. A Terminal Disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

14. Claims 21-94 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 21-94 of each of the following copending applications:

08/463823, 08/463111, 08/463821, 08/465200, 08/465199, 08/465658, 08/469321, 08/471695, 08/471553, 08/471600, 08/471701, 08/471123, 08/471425, 08/471136, 08/469580, 08/469889, 08/464034, 08/465173, 08/465071, 08/465657, 08/463822, 08/465072, 08/469262, 08/469261, 08/469263, 08/466600, 08/466599, 08/469407, 08/471633, 08/471542, 08/469888, 08/466557, 08/470569, 08/471846, 08/469592, 08/469060, 08/471255, 08/471042, 08/471252.

15. Rather than repeating the extensive discussion of the reasons for rejection, the statements advanced in the previous Office Action as to the applicability of the rejection are incorporated herein, as are the statements of rejection for these claims.

16. Claims 95-97 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 8 of U.S. Patent No. 4,491,930 in view of Marsh (US 4,179,824).

17. Rather than repeating the extensive discussion of the reasons for rejection, the statements advanced in the previous Office Action as to the applicability of the rejection are incorporated herein, as are the statements of rejection for these claims.

18. Claims 95-97 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 95-97 of each of the following copending applications:

08/463823, 08/463111, 08/463821, 08/465200, 08/465199, 08/465658, 08/469321, 08/471695,

Serial Number: 08/464034
Art Unit: 2616

-10-

08/471553, 08/471600, 08/471701, 08/471123, 08/471425, 08/471136, 08/469580, 08/469889.

19. Rather than repeating the extensive discussion of the reasons for rejection, the statements advanced in the previous Office Action as to the applicability of the rejection are incorporated herein, as are the statements of rejection for these claims.

Double Patenting - Non-Statutory/Non-Obvious-type

20. Claims 21-97 are rejected under the judicially created doctrine of double patenting over claims 21-97 of each of the copending applications listed below:

08/464034, 08/465173, 08/465071, 08/465657, 08/463823, 08/463822, 08/465072, 08/463111, 08/463821, 08/465200, 08/465199, 08/465658, 08/469262, 08/469261, 08/469263, 08/466600, 08/466599, 08/469407, 08/471633, 08/471542, 08/469321, 08/471695, 08/471553, 08/471600, 08/471701, 08/471123, 08/471425, 08/471136, 08/469580, 08/469889, 08/469888, 08/466557, 08/470569, 08/471846, 08/469592, 08/469060, 08/471255, 08/471042, 08/471252.

21. Rather than repeating the extensive discussion of the reasons for rejection, the statements advanced in the previous Office Action as to the applicability of the rejection are incorporated herein, as are the statements of rejection for these claims.

22. Claims 21-94 are rejected under the judicially created doctrine of double patenting over claims 25, 26-28 and 58 of U.S. Patent No. 4,954,951 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

23. Rather than repeating the extensive discussion of the reasons for rejection, the statements advanced in the previous Office Action as to the applicability of the rejection are incorporated herein, as are the statements of rejection for these claims.

Drawings

24. The drawings are objected to under 37 C.F.R. § 1.83(a). The drawings must show every feature of the invention specified in the claims. Applicant's claims recite a number of embodiments of the invention. However, no embodiment appears to be shown in its entirety in any of the drawings, and therefore the structural relationships between elements

as recited in the claims are not shown in the drawings. In addition, the claims recite a number of embodiments which process or generate particular types of images. The drawings do not show the specific embodiments of the invention which process or generate the following types of images: scaled, perspective, antialiased, scanned out, filtered, occulted, range-related and database. If Applicant believes every claimed feature as indicated above is present in the drawings, in his response to this objection, he should point out the specific figures and elements in the drawings which show these features. These features must be shown or the features cancelled from the claims. No new matter should be entered.

25. While applicant, in his response, points to certain Figures as allegedly showing these various features, the only features that apparently are actually shown are the "rotation" and "translation" (and the objections to these features are hereby withdrawn). Contrary to what applicant argues, 37 C.F.R. § 1.83(a) clearly states that each and every feature of the claims must be shown in the drawings. If applicant can not point to specific Figures that show each and every limitation in the various claims, particularly the explicitly pointed to features above, these features should and must be cancelled from the claims.

Response to Applicant's Remarks

26. With respect to applicant's remarks on page 2, second full paragraph, applicant's remarks are not persuasive nor are they accurate. Specifically, while Marsh may, and does, disclose many things, one of the things that he does disclose is the various claim limitations as indicated in the previous Office Action. Further, while applicant states that "the claims are expressly limited to a novel memory arrangement", this is not entirely accurate, as the claims all recite "An image processing system" rather than "a memory arrangement" or a "memory system". If applicant really believed that the claims were directed to a memory system then the claims should have been drafted as memory systems rather than as image processing claims.

27. With respect to applicant's remarks on page 2, third full paragraph, applicant's

remarks are not persuasive nor are they accurate. Specifically, nowhere in the section cited by applicant did the examiner "expressly disregard limitations of the claims". While the examiner did indicate that the variously recited adjectives apparently had little if any material impact on the limitations of the claims, he also stated that these modifiers would be subsequently addressed after the base limitations of the claims were addressed. This is exactly what the Examiner did in the action and the modifiers were indeed addressed in later sections of the Action.

28. As to applicant's remarks at the bottom of page 2 of the response, firstly applicant's disclosure or claims WERE NOT used as a guide to interpreting the references as charged by applicant. The statement of inherency of elements or steps is a long accepted practice. Because a reference may not explicitly recite the existence of a means or step that is extremely conventional and must be performed the reference is not necessarily lacking that means or step. By arguing that a given means or step is inherent, the Examiner is simply indicating that certain means or steps must be included in the reference because of both the conventionality and the necessity of such a means or step. For example, in section 7 of the last Action, the Examiner stated that Marsh inherently includes means for transmitting processed data to a memory and means for addressing the memory. These are both very conventional means/steps as well as necessary means/steps. The processed data is stored in the memory, therefore there MUST be a means to transmit the processed data to the memory as well as means to address the memory. If such a means were not present the system would not function. If it is actually applicant's contention that the use of a means to transmit processed data from a processor to a memory for storing the processed data (as clearly in Marsh) and a means to address the memory are not inherent in Marsh (or any other similar system) it is strongly suggested that applicant present complete technical support for this assertion. At present, the Examiner is not aware of any technology that allows data to be processed by a processor and appear in a memory without being transmitted by some means to the memory. Further, any conventional memory needs to have an addressing circuit to designate what address data is being stored to and read from.

29. Further, with respect to applicant's remarks from the bottom of page 2 to the top of

page 3 (as well as later in the Action) directed to the taking of Official Notice and the reliance on what is conventional and well known in the art, this also is a long established and accepted procedure (see, for example, *In re Malcom*, 129 F2d 529, 54 USPQ 235 (CCPA 1942). For a full discussion of this see MPEP 2144.03 (Rev. 1, Sept. 1995). In brief, this section states that for issues that are extremely well known and conventional, Official Notice may be taken. Further, applicant could have followed the procedure recited therein for the proper and timely challenging of the taking of Official Notice. If such were timely and properly done, references would have been supplied to support the takings of Official Notice. However, applicant has not properly challenged the taking. MPEP 2144.03 states that if "applicant does not seasonably traverse the well known statement during examination, then ...is taken to be admitted prior art" (emphasis added) and that a "seasonable challenge constitutes a demand for evidence made as soon as practicable during prosecution. Thus, applicant is charged with rebutting the well known statement in the next response after the Office Action in which the well known statement was made." (emphasis added). Further, this section of the MPEP states a challenge "must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying judicial notice" (emphasis added) (see *In re Boon*, 439 F2d 724, 169 USPQ 231 (CCPA 1971). Applicant has not at all met this burden as applicant has only extremely briefly even mentioned this issue and provides no information or arguments as to why the taking of Notice is improper or that the points Notice was taken of were not indeed conventional and well known. Additionally, applicant has not in any way addressed any specific limitation as to which he objects to the taking of Official Notice. Further, for the record, the same issue of not seasonably and properly challenging the taking of Official Notice has been raised in the parent application (SN 07/289,355, now on appeal). Therefore, it is believed that applicant was well aware of the responsibilities and procedures for seasonably and properly challenging the taking of Official Notice.

30. As to the remarks in paragraph 3 of page 3 directed to the application of the Widergren as a reference to a number of the claims, applicant's remarks are not accurate. The claims specified in the rejection (25, 30, 35, 42, 50, 57, 64, 69, 74, and 79) contain

substantially the same limitations as those in the specified appeal. While these are dependent claims, and the parent claims do contain additional limitations, what these claims themselves recite is substantially the same as those in said appeal. Further, it is noted that the rejection is one of obviousness and Widergren was applied to show what these claims themselves recite. Therefore, the same analysis applies.

31. As to the remarks presented from the middle of page 3 to the top of page 6, while the remarks have been considered, they are not convincing. Specifically, not only are all of the elements shown by the references (or inherent or Official Notice taken of), there are also reasons given as to the obviousness of combining the references. Contrary to what applicant alleges, the references are not totally unrelated references. The similarities of the references and combinability are clearly and completely presented in said action. Further, it is not necessary for the references to explicitly state the possibility of combining with specific other references. Reasons for combining may be in the references, though it is not necessary. Suggestions or reasons for combining can also come from other references and from what is well known or conventional in the art, as well as from various other sources. Additionally, applicant is apparently taking a much too narrow interpretation of the references (though this can not be determined exactly from applicant's remarks, as the specifics of the references are only very briefly mentioned therein). The references must be looked at to determine all of what they teach to one of ordinary skill in the art. For example, a reference directed to the processing of generic images may well also contain some disclosure as to how the processed data is stored and other memory manipulations. Thus, the reference would be applicable to not only image processing in general, but to memory systems and architecture (both for imaging systems as well as most other data processing/handling systems), as well as for numerous image processing applications, such as possibly character recognition, image alignment, medical image processing, signature recognition, simulators, and numerous other fields.

32. As to the first paragraph on page 7, directed to the double patenting rejections, applicants' remarks are not at all understood. In what way does the Fifth Amendment to the Constitution "require[s] a rejection to set forth the reasons for the rejection with

sufficient specificity for an applicant to determine the nature of the rejection and to challenge the rejection". It is not believed that the Fifth Amendment to the Constitution makes reference to patenting examination nor to the contents of a rejection in the examination of a patent application.

33. As to applicant's remarks from the middle of page 7 to the middle of page 8 directed to the obviousness based double patenting rejections, applicant does not appear to attempt to refute the applied art or arguments. Rather he simply cites various decisions (some apparently unpublished) that appear to have very little, if anything to do with double patenting rejections. Therefore, these remarks are not found to be in any way convincing to the issue at hand.

34. As to the remarks at the middle of page 8 of the response, applicant argues that there is no basis to combine Marsh and the material in claim 8 of the '930 patent and that the equating of rotation and translation to filters is erroneous. As to the first point, Marsh discloses a system with substantial memory architecture and processing. Therefore, as argued above, it is indeed applicable to the material of claim 8 in the '930 patent. As to the second point, it is firstly noted that these limitations only appear in claim 95 and not in 96 or 97. Secondly on this point, this is not an accurate interpretation of the actual rejection. The Marsh reference was cited for showing the rotation and translation. The filter claimed in the '930 patent was not said to be a means to perform rotation or translation, *per se*, but was broad enough to cover these functions (particularly when looking to the '930 specification for definitions of the term. For example, column 6, lines 18-25, 36-53 of the '930 patent define the filter means as encompassing many types of digital filtering or signal processing.).

35. With respect to the remarks on the bottom of page 9 directed to the objection to the drawings, applicant's remarks are not found to be convincing. As stated above, each and every limitation being claimed must be shown in the drawings or the material must be removed from the claims. The drawings pointed to by applicant do not show all of the claimed material.

36. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of

Serial Number: 08/464034
Art Unit: 2616

-16-

time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Contact Information

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Larry J. Priokockis, who can be reached at (703) 305-4791.

If attempts to reach the Examiner(s) by telephone are unsuccessful, the Examiner's supervisor, Michael Razavi, can be reached at (703) 305-4713.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-8576.

The Art Unit FAX number is (703) 308-6606.


LJP

June 26, 1996

